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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

07/25/96

DATE MAILED

This application has been examined Responsive to communication filed on 5/31/96 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 10 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1. Claims 1 and 3-22 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims 2 have been cancelled.

3. Claims _____ are allowed.

4. Claims 1 and 3-22 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received; not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

1. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claims 1 and 2-14 are rejected under 35 U.S.C. § 103 as being unpatentable over Nosek in view of Sheehan, Cheesman et al, Fabian, Ghaem et al, and Ruiz et al. Nosek discloses an apparatus for counting the number of, and determining the amount of blood contained within, surgical sponges (Col. 1, ln.s 33-50; Col. 4, ln.s 28-49) including a container (7) for holding used surgical sponges, detecting means (Col. 2, ln.s 3-13; Col. 4, ln.s 11-27), display means (Col. 6, ln.s 26-32), determining means for determining the dry weight of a sponge (Col. 3, ln.s 43-49; Col. 5, ln.s 42-60; Col. 7, ln.s 10-29), an alarm (Col. 3, ln.s 8-14), and weighing means (Col. 4, ln.s 2-10). Nosek discloses the claimed invention except for the second display means, the RF non-optical scanning means, the disposable plastic bag, the alarm for signaling when the container is full, the use of battery power, and the alarm for determining when the battery is low. Sheehan teaches that it is known to use more than one display in a blood loss calculating scale in order to display more than one type of information at a time (Col 2, ln.s 20-48). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use more than one display in the blood loss calculating scale of Nosek, as taught by Sheehan, in order to display more than one type of information at a time.

Cheesman et al teach that it is known to use a disposable plastic bag in a blood loss calculating scale in order to allow for quick, easy, sanitary disposal of the bloody sponges (Col. 7, ln.s 22-33). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a disposable plastic bag in the scale of Nosek, as taught by Cheesman et al, in order to allow for quick, easy, sanitary disposal of the bloody sponges.

Fabian discloses a RF tag attached to a surgical sponge in order to allow it to be easily traced (Col 1, ln.s 34-47; Col. 3, ln. 64 to col. 4, ln. 16; Col. 5, ln.s 23-63; Col. 7, ln.s 30-36). Ghaem et al teach that it is known to encode information about an attached article into a RF tag in order to allow accurate inventory control (Col. 1, ln.s 37-62). Because Nosek discloses that any form of conventional identifying means can be attached to his sponges (Col . 4, ln.s 11-16), and because Nosek teaches keeping inventory of various items (Col. 5, ln.s 49-60; Col. 8, ln.s 15-18), it would have been obvious to one having ordinary skill in the art at the time the invention was made to encode the RF tag of Fabian with information about the attached sponge, as taught by Ghaem et al, in order to allow accurate inventory control in the apparatus of Nosek.

Ruiz et al teach that it is known to signal an alarm if the rate of fluid loss/gain from a patient exceeds a certain amount (Col. 5, ln.s 5-18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to signal when the fluid loss calculated by the apparatus of Nosek exceeds a certain level in order to alert the medical staff of the patient's condition.

Nosek does not disclose the use of batteries or the low battery alarm. It would have been an obvious matter of design choice to power the device of Nosek with batteries and to provide a low battery alarm, since applicant has not disclosed that using batteries solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with batteries or an A/C source.

3. Claims 15-22 are rejected under 35 U.S.C. § 103 as being unpatentable over Fabian ('095) in view of Ghaem et al. Fabian discloses a RF tag attached to a surgical sponge (Col. 3, ln. 64 to col. 4, ln. 16; Col. 5, ln.s 23-63; Col. 7, ln.s 30-36). Fabian discloses the claimed invention except the tag does not contain information about the attached sponge, and the physical dimensions of the tag are not specified. Ghaem et al teach that it is known to encode information about an attached article into a RF tag in order to allow accurate inventory control (Col. 1, ln.s 37-62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to encode the RF tag of Fabian with information about the attached sponge, as taught by Ghaem et al, in order to allow accurate inventory control.

Fabian does not disclose the physical dimensions of his RF tag. It would have been an obvious matter of design choice to any conventional RF tag with any desired dimensions, since applicant has not disclosed that the size of the tag solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any conventionally sized RF tag.

4. Applicant's arguments filed May 31, 1996 have been fully considered but they are not deemed to be persuasive. Nosek discloses an optical scanning means for automatically detecting the presence of a sponge in the opening of his apparatus, but he states that the details of the scanning means is not part of his invention (Col. 4, ln.s 11-20). Fabian teaches that placing an RF tag on a sponge aids in its detection, thereby allowing medical room personal to easily locate a sponge even if it is left in a patient's body (Col. 3, ln.s 22-35); this is an added safety feature which can not be matched by the optically scanned indicia on the sponges of Nosek (Col. 7, ln.s 10-29). Ghaem et al further teach that by placing an RF tag on an item, information about that item, such as size and weight, can be encoded

into the tag to allow fast, easy, and accurate inventory control (Col. 1, ln.s 37-55). This would help Nosek avoid the inherent human errors caused by his method of entering inventory data by hand. Therefore, the motivation for combining a known non-optical scanning method and a known non-optical scanner with the device of Nosek is found in the prior art references of record. Gleam et al teach that keeping inventory control by using an RF tagging system allows fast, accurate and easy inventory control when compared with other inventory control systems in the prior art (Col. 1, ln.s 45-55). Because one feature of the system of Nosek is inventory control (Col. 7, ln.s 10-31; Col. 8, ln.s 15-62), it would have been obvious to modify the apparatus of Nosek to include an inventory tracking system which is faster, more accurate, and easier to use than his disclosed method. Since Nosek does not disclose that he is concerned about the cost of his system, and since Gleam et al does not indicate that their system is overly complex or expensive compared to the prior art, the applicant's argument that the RF tag and detection system of Gleam et al is too expensive to incorporate into the apparatus of Nosek is not persuasive. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

5. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication should be directed to R. Gibson at telephone number (703) 308-1765.



MICHAEL L. GELLNER
SUPERVISORY PATENT EXAMINER
GROUP 2100

Gibson *RWJ2*
February 13, 1996